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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/081,872    05/20/98    MESSING

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EXAMINER
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WM31/0925

JOHN H MESSING  
6571 NORTH SILVER SMITH PLACE  
TUCSON AZ 85712

ART UNIT	PAPER NUMBER
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2132  
DATE MAILED:

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09/25/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

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# Office Action Summary

Application No.

09/081,872

Applicant(s)

MESSING, JOHN H.

Examiner

Douglas J Meislahn

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 36-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☒ Interview Summary (PTO-413) Paper No(s). 17
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the RCE filed 16 July 2001 that caused the entry of the after-final amendment originally received 18 June 2001. The amendment cancelled claims 20-35 and added claims 40-55 while amending the specification.

### ***Response to Arguments***

2. Applicant's arguments filed 16 July 2001 have been fully considered but they are not persuasive.

3. Applicant argues that the rejection of claims 36 and 37 is improper because there is nothing in the claims pertaining to credit cards. This is irrelevant because the claims do not exclude a system that uses credit card templates.

4. Applicant has attempted to traverse the taking of official notice but has not rebutted the official notice itself. As such, the official notice is maintained. MPEP 2144.03.

5. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the verification of data at the signing authority) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

6. In the interview of 02 August, the examiner stated that claim 40 had overcome the prior art because it necessitates that the signing authority be used for

authentication. Claims 36, 50, and their dependents do not contain this feature, and hence the previously cited prior art is still applicable to them.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 37, 38, and 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Regarding claims 37 and 38, the phrases "or other methods" (claim 37) and "or any other method" (claim 38) render the claims indefinite because the claim includes elements not actually disclosed (those encompassed by the cited phrases), thereby rendering the scope of the claims unascertainable. See MPEP 2173.05(d). As such, these claims are unexamined.

10. Applicant's claims are replete with errors of form. The examiner has attempted to find all of them. Given their abundance, it is doubted that all have been identified. As such, applicant's aid is requested in their correction.

11. The period at the end of line 19 of claim 40 needs to be removed. "Other methods" in the second to last line of claim 40 suffers the same problem as the above-mentioned phrases in claims 37 and 38, although in this case the claim is still examinable. Similarly, "other knowledge based system" is also inappropriate in claim 49. In claim 44, "the actions" lacks antecedent basis. Claim 55 recites "any or all"

which is indefinite as well as citing "the methods of this invention" which is also indefinite. Hence this claim is unexamined.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

13. Claims 40, 41, 43, 45, 47, and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Kocher (6188766).

Lines 26-37 of column 7 disclose many identifiers of a sending entity, some of which are explicitly sent to a timestamping archive. The archive corresponds to applicant's server system, the sending entity to applicant's client. Thus, clause a1 is anticipated. Element 210 of figure 2 is the reception of a document from the client at the archive. This would necessitate the establishment of a document and the intent of the client to send the document to the archive. Thus limitations a2 and a3 are covered.

Element 220 of figure 2 shows the archive authorizing the sender. This meets the limitations of element b1. Element 230 timestamps the document. In lines 38-45 of column 10, Kocher expands on this, saying that the timestamping might include signing. This anticipates clause b2. Incidentally, the identifier is also signed since it is potentially part of the document sent to the archive. Element 320 of figure 3 anticipates clause b3. The final clause of applicant's claim is inherent from the disclosure of Kocher.

With respect to claim 41, Kocher teaches TTIs in lines 48-52 of column 3. These read on unique identifiers. In lines 39-40 of column 7, Kocher mentions network addresses as identifiers. Figure 3 anticipates claim 43: clause 1 of the claim is inherent from element 310; clause 2 is a result of the reception of the DIV in element 300; clause 3 is shown by element 340. Line 35 of column 7 mentions credit card numbers, thereby meeting the limitations of claim 45. The phrase "electronic process" is broad enough to include the client's computer, anticipating claim 47. In line 30 of column 7, a client authenticates itself through knowledge of a dedicated phone line number, which anticipates claim 49.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kocher.

Kocher shows a timestamping archival facility that signs and authenticates documents. He does not say that clients are authenticated using biometric identifiers. Official notice is taken that it is old and well known to use biometric identifiers to authenticate entities. Biometrics uniquely identify entities. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to identify the client in Kocher using a biometric to ensure uniqueness.

16. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kocher.

Kocher shows a timestamping archival facility that signs and authenticates documents. He does not say that client actions are carried out as a result of voice commands. Official notice is taken that it is old and well known to effectuate actions through voice commands. Voice commands are convenient. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to effectuate the indication to sign via voice commands because it is convenient.

17. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kocher.

Kocher shows a timestamping archival facility that signs and authenticates documents. He does not say that the client countersigns the document. Official notice is taken that it is old and well known to countersign documents. This provides a further level of proof of acceptance of the now-countersigned document. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made for the client to countersign the document that had been signed by the timestamping archive to show an added level of agreement.

18. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kocher.

Kocher shows a timestamping archival facility that signs and authenticates documents. He does not say that the signature is performed through a symmetric encryption using a key that is derived from the unique document identifier. Please note that in lines 46-47 of column 13, Kocher says that any algorithm may be used in the signature. Official notice is taken that it is old and well known to create symmetric keys based on identifiers. This efficiently assigns keys to entities identified by the identifiers. Official notice is taken that MACs, which are essentially signatures using symmetric

keys, are old and well known. These signatures are less computationally complex than public key signatures. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the signature using a keyed MAC, wherein the key was derived from the unique identifier of the document.

19. Claims 36, 39, and 50-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kocher.

Kocher shows a timestamping archival facility that signs and authenticates documents. This anticipates clause a. Clause b is anticipated by lines 27-37 of column 7, clause c by element 22 of figure 2. Clauses f and g are anticipated by the TTI and the need for the client to send the document to the archive. Kocher does not say that the documents to be signed are based on templates that are filled out by the client. Official notice is taken that it is old and well known to use templates to collect data. This is especially relevant to e-commerce where credit card information is supplied by filling out a web page. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made for Kocher's archive to receive, sign, and later verify documents that are templates filled out with client-supplied information. This would prove useful for on-line transactions. The limitations of claim 36 are met for the same reasons.

Claim 51 is obvious because, in one embodiment, Kocher's documents are formatted, as can be seen in element 210 of figure 2. Claim 52 is obvious because templates that include legal disclaimers are known in the realm of templates.



Claims 39, 53, and 54 are rendered obvious for the same reason that claims 44 and 48 were rejected. That is, the additional elements are old and well known, and it would have been obvious to implement them in the Kocher's system.

20. Claims 36 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ford et al.

Ford et al. show an originator sending a document to a trusted third party who authenticates, signs, and returns the document. They do not say that the document includes template information or approval for a credit card transaction. Official notice is taken that online shopping using credit cards is old and well known. In this case, a user inputs information into a template, such as credit card information. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow for online transactions in the system of Ford et al.

21. Claims 39, 52, and 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ford et al.

Ford et al. show an originator sending a document that includes template information to a trusted third party who authenticates, signs, and returns the document. They do not say that the signature is a MAC or that the encryption key is a product of the document's unique identifier. Official notice is taken that it is old and well known to create symmetric keys based on identifiers. This efficiently assigns keys to entities identified by the identifiers. Official notice is taken that MACs, which are essentially signatures using symmetric keys, are old and well known. These signatures are less computationally complex than public key signatures. Therefore it would have been

Art Unit: 2132

obvious to a person of ordinary skill in the art at the time the invention was made to use MACs using keys derived from the document to be signed to sign the documents of Ford et al.

***Conclusion***

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Palage et al. (6018801) and Bisbee et al. (6237096).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas J. Meislahn whose telephone number is (703) 305-1338. The examiner can normally be reached between 9 AM and 6 PM, from Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail Hayes can be reached on (703) 305-9711. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0040 for regular communications and (703) 308-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



DJM

August 28, 2001

Douglas J. Meislahn  
Examiner  
Art Unit 2132



GAIL HAYES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100